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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,204	09/15/2003	Vipul Ved Prakash	6747P004	2360

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EXAMINER

HOANG, HIEU T

ART UNIT	PAPER NUMBER
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2152

MAIL DATE	DELIVERY MODE
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04/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,204

Applicant(s)

PRAKASH, VIPUL VED

Examiner

HIEU T. HOANG

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9-13, and 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/14/2008 has been entered.

2. Claims 1, 3-7, 9-13, and 15-25 are pending.

Response to Arguments

3. Applicant's arguments have been fully considered but they are moot in views of new ground(s) of rejection.

Claim Objection

4. Claims 7 and 9-12 are objected to because of the following informalities: the claims recite "a computer-readable storage medium". However, no explicit definition of "a computer-readable storage medium" is found in the specification. For examining purpose, the claimed "computer-readable storage medium" will be read as typical computer storage medium such as computer discs or memory, and not including transmission medium. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 6, 7, 12, 13, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US 6,957,259), further in view of DiStefano III (US 6,631,400, DiStefano).

7. For claim 1, Malik discloses a method to manage mass publication delivery, the method comprising:

- content publishers, who publish electronic publications, registering the electronic publications with a server accessible by a plurality of clients (col. 6 lines 49-67, col. 7 lines 47-55, col. 8 lines 4-9, a postmaster registers his email profile at a server);
- the server storing the registered electronic publications in a database (col. 7 lines 38-46, store received registered emails in a database);

- configuring the plurality of clients to query the database to determine if a publication addressed to at least one of the plurality of clients received is registered (fig. 5A, receive emails and determine if emails are of registered source); and

Malik does not explicitly disclose:

- the server placing one or more of the registered electronic publications on one of a subscribed and unsubscribed list based on input from a user;

However, DiStefano discloses:

- the server placing one or more of the registered electronic publications on one of a subscribed and unsubscribed list based on input from a user (col. 5 lines 41-47, col. 5 line 66- col. 6 line 2, users opt in to receive registered content, server match registered emails to user's topic, col. 1 lines 42-64, opt in subscribe list for users)

Malik-DiStefano then discloses:

- delivering the publication to an inbox associated with the at least one of the set of clients if the publication is registered and is on the subscriber list (Malik, fig. 5B, deliver emails if registered, DiStefano, col. 1 lines 42-64, and in user opt-in list).

Therefore, it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Malik and DiStefano to take advantage of opt-in features of DiStefano.

8. For claims 7 and 13, the claims are rejected for the same rationale as in claim 1.

9. For claims 6, 12, and 18, Malik-DiStefano discloses the invention substantially as in claims 1, 7, and 18. Malik-DiStefano further discloses the publication includes a mass email publication (Malik, col. 2 lines 26-27, mass emailing).

10. Claims 3-5, 9-11, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik-DiStefano, further in view of Kirsch (US 2004/0177120).

11. For claims 3, 9, and 15, Malik-DiStefano discloses the invention substantially as in claims 2, 8, and 14. Malik-DiStefano does not explicitly disclose the delivering includes delivering if the publication has not been placed on the unsubscribed list. However, Kirsch discloses the same (DiStefano, [0025], fig. 2 steps 32-34, black list). Therefore, it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Malik-DiStefano and Kirsch to take advantage of black listing features of Kirsch.

12. For claims 4, 10, and 16, Malik-DiStefano discloses the invention substantially as in claims 1, 7, and 13. Malik-DiStefano does not disclose configuring each client to perform an authentication operation to authenticate the content publisher; and to deliver the publication if the content publisher has been authenticated. However, Kirsch discloses the same (Kirsch, [0035], authentication of a sender by using a signature in conjunction with some other information). Therefore, it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Malik-DiStefano and Kirsch to take advantage of authentication features of Kirsch.

13. For claims 5, 11, and 17, Malik-DiStefano-Kirsch discloses the invention substantially as in claims 4, 10, and 16. Malik-DiStefano-Kirsch further discloses the authentication operation comprises sending authentication information received from the content publisher to the server for verification of the authentication information (Kirsch, [0035], authentication of a sender by using a signature combined with some other information).

14. Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik, in view of Michael (US 2002/0188689), further in view of Kirsch.

15. For claim 19, Malik discloses a method to filter electronic publication, the method comprising:

content publishers, who publish electronic publications, registering the electronic publications with a server accessible by a plurality of clients (col. 6 lines 49-67, col. 7 lines 47-55, col. 8 lines 4-9, a postmaster registers his email profile at a server);

determining if the content publisher has registered the electronic publication with the server (fig. 5A, receive emails and determine if emails are of registered source)

Malik does not disclose for each of the electronic publications, the server randomly assigning a unique address to a respective content publisher, assigning an identification to a respective publication, and storing only the unique address, the identification, and a name of the respective publication in a database;

However, Michael discloses the same (fig. 16, a database storing content publisher and publication identifiers, e.g., "Gardening R Us" magazine 123-abc)

Malik-Michael does not explicitly disclose:

receiving at a client an electronic publication from a content publisher; and wherein the database further stores a subscribed list comprising a first set of electronic publications for which a subscription is unblocked and thus allowed to reach an inbox of the client and an unsubscribed list comprising a second set of electronic publications for which a subscription is blocked and are to be deleted instead of being placed in the inbox of the client.

However, Kirsch discloses using user white list and black list for allowing and blocking emails from reaching user's inbox (fig. 2, steps 28-34, [0025], white list, black list)

Therefore, it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Malik, Michael and Kirsch to take advantage of user white list and black list features of Kirsch, also identifying electronic messages using identifiers as disclosed by Michael.

16. For claim 20, Malik-Michael-Kirsch further discloses the determining if the content publisher has registered the electronic publication with the server comprises: computing a signature of the publication; and sending the signature to the system to check if a signature corresponds to a registered publication (Michael, fig. 16, signature of publication, Kirsch, [0035], [0056], compute sender identification hash code and look up).

17. For claim 21, Malik-Michael-Kirsch further discloses the system is remote from the client (Kirsch, fig. 1, central database in a third party server).

18. For claim 22, Malik-Michael-Kirsch further discloses placing the publication in an inbox of the client if the publication is registered with the server and is on the subscribed list (Malik, fig. 5B, deliver emails if registered, Kirsch, fig. 2 step 34, white list).

19. For claim 23, Malik discloses a method to manage mass publication deliver, the method comprising:

content publishers, who publish electronic publications, registering the electronic publications with a server accessible by a plurality of clients (col. 6 lines 49-67, col. 7 lines 47-55, col. 8 lines 4-9, a postmaster registers his email profile at a server);

Malik does not disclose for each of the electronic publications, the server randomly assigning a unique address to a respective content publisher, assigning an identification to a respective publication, and storing only the unique address, the identification, and a name of the respective publication in a database;

However, Michael discloses the same (fig. 16, a database storing content publisher and publication identifiers, e.g., "Gardening R Us" magazine 123-abc)

Malik-Michael does not explicitly disclose:

receiving a request from a client to determine if a publication identified in the request is registered with the server (fig. 2 step 60);

checking if the publication is registered with the server (fig. 2 step 62); and
sending a result of the checking to the client (fig. 2 step 34).

However, Kirsch discloses:

receiving a request from a client to determine if a publication identified in the request is registered with the server (fig. 2 step 60);

checking if the publication is registered with the server (fig. 2 step 62); and
sending a result of the checking to the client (fig. 2 step 34).

Therefore, it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Malik, Michael and Kirsch to take advantage of user white list and black list features of Kirsch, also identifying electronic messages using identifiers as disclosed by Michael.

20. For claim 24, Malik-Michael-Kirsch further discloses receiving input from a plurality of separate clients; and computing an index for each registered publication based on the input, wherein the index provides an indication of how many users in a community of users have indicated that the registered publication is unwanted (Kirsch, [0013], the rating is based on multiple users' inputs).

21. For claim 25, Malik-Michael-Kirsch further discloses sending the index to the client (Kirsch, [0013]).

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu T. Hoang whose telephone number is 571-270-1253. The examiner can normally be reached on Monday-Thursday, 8 a.m.-5 p.m., EST.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HH

/Bunjob Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2152